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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER BORISSOV, IGOR N	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/024,482  
Filing Date: December 21, 2001  
Appellant(s): GIACCHETTI, DANIELA

**MAILED**

**AUG 24 2007**

**GROUP 3600**

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Jeremy T. Thissell  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 05/10/2007 appealing from the Office action mailed 12/14/2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US 6,937,755 B2	Orpaz et al.	Aug. 30, 2005
US 2002/0024528 A1	Lambertsen	Feb. 28, 2002

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15 and 18-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a "useful, concrete and tangible result" is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "useful, concrete and tangible result". The test for practical application as applied by the examiner involves the determination of the following factors":

**(a) "Useful"** - The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

**(b) "Tangible"** - Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

**(c) "Concrete"** - Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

Claim 1 recites:

*facilitating* display, on a display device, of a plurality of templates, wherein at least some of the templates are representative of a portion of a face having a simulation of use of a beauty product;

*enabling* selection of at least one of the displayed templates; and

*facilitating* display, on the display device, of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product,

wherein the displayed facial portion having a simulation of the simulated facial image corresponds to a facial portion of the at least one selected template, and wherein the simulation of the displayed facial portion corresponds to a simulation of the at least one selected template.

Specification provides the following definitions of terms "facilitating" and "enabling":

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"As explained in various portions of this document, the "facilitating" could involve either direct or indirect activity." (Page 27, lines 17-18).

"The "enabling" of an individual to construct a simulated facial image may involve direct activity or indirect activity." (Page 10, lines 8-9).

Accordingly, based on the definitions of said terms provided by the specification, the method step of: "facilitating display" does not require the actual act of "displaying" to be performed, and the method step of "enabling selection of at least one of the displayed templates" neither require the actual selection step to be performed, nor does it guarantee the expected result of the selection step, and can be understood as merely having an idea about how to arrange the selection of the information.

35 U.S.C. § 101 provides:

Whoever invents or discovers any new and useful **process, machine, manufacture, or composition of matter**, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Traditional process can be understood as either transforming subject matter or implemented by one of the other three categories. See *Tilghman v. Proctor*, 102 U.S. 707, 722 (1880) ("where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations are called processes."); see also *AT&T*, 172 F.3d at 1356, 50 USPQ2d at 1450 ("any step-by-step process, be it electronic, chemical, or mechanical, involves an 'algorithm' in the broad sense of the term.").

Method claim 1 does not recite any electrical, chemical, or mechanical acts or results, typical in traditional process claims; the claim does not require any machine or apparatus to perform the recited steps; and, finally, the claim does not provide any physical transformation of an article to a different state or thing, nor does it require any transformation of data or signals. However, "...a process claim [in] compliance with

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Section 101 requires some kind of transformation or reduction of subject matter.”  
See *In re Schrader*, 22 F.3d 295, 30 USPQ2d at 1459.

Accordingly, so as the method claim 1 does not require any machine or apparatus to perform the recited steps, and does not require implementing a mathematical formula or algorithm to transform data, the information recited in the claim does not represent a real world activity such as found in *Arrhythmia*, *Alappat*, or *State Street*. As such, claim 1 falls outside the scope of § 101 as failing to produce a useful and concrete and tangible result.

Same reasoning applied to method claim 18.

The dependent claims 2-15 and 19-21 do not cure the “101” deficiency of the independent claims. Accordingly, reasoning applied to claim 1 and 18 is equally applied to the dependent claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-11 and 13-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Orpaz et al. (US 6,937,755).**

Orpaz et al. (Orpaz) teaches a computer-implemented method, system and computer-readable medium having computer-executable instructions embodied therein

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for causing a computer to implement said method for simulating an appearance of make-up and fashion accessories on an human image, said system including a processor and a wide area network, said method comprising:

Independent Claims

Claims 1, 16, 17 and 18.

Facilitating of displaying a plurality of templates, wherein at least some of the templates are representative of a portion of a face having a simulation of use of a beauty product (Fig. 3 discloses an image simulation graphic interface (ISI) 33, including a plurality of symbols/images/templates (a central picture and category list) including eyes and lips & face, which, when selected, provide more detailed choices (subcategories), i.e., lipstick, lip-gloss, lip pencil, eye shadow, eyeliner, mascara, eye pencil, etc., Figs. 12-18; C. 3, 34-43; C. 6, L. 20-41);

enabling selection of at least one of the displayed templates (so as only some of the templates *are representative of a portion of a face having a simulation of use of a beauty product* (see “displaying” step), the selected template can be any one of said, disclosed in Orpaz, central picture and category list (plurality of templates) including eyes and lips & face, which, when selected, provide more detailed choices (subcategories), i.e., lipstick, lip-gloss, lip pencil, eye shadow, eyeliner, mascara, eye pencil, etc. (Fig. 3; C. 3, L. 36-37);

facilitating display, on the display device, of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion of the simulated facial image corresponds to a facial portion of the at least one selected template, and wherein simulation of the displayed facial portion corresponds to a simulation of the at least one selected template (after selection of the desired subcategory, the appearance of the base image, or at least the appearance information of the associated make-up application area, is modified, thereby simulating the physical process of color application (C. 6, L. 66 - C. 7, L. 13); (the *at least one selected template which the displayed facial portion of the simulated facial image corresponds to* can be any one from said category list (plurality of templates) in Orpaz).



Dependent Claims

Claim 2. Said method, wherein the plurality of templates comprise a group of templates each having substantially the same shaped facial portion along with a simulation of a differing beauty product (C. 2, L. 63-66).

Claim 3. Said method, wherein the beauty product comprises make-up, and wherein each template in the group of templates has a simulation of a differing make-up (C. 2, L. 63-66).

Claim 4. Said method, wherein each template in the group has a simulation of make-up with at least one of a differing color, a differing texture, a differing brand, and a differing formulation (C. 3, L. 10-12, 47, 53-55; C. 4, L. 5-11).

Claim 5. Said method, wherein the plurality of templates Comprise a group of templates each having a different shaped facial portion (Figs. 12-18).

Claim 6. Said method, wherein the facial portion is chosen from lips, eyes, cheeks, and eyebrows (Figs. 12-18).

Claim 7. Said method, wherein the beauty product comprises make-up (C. 1, L. 50-54; C. 5, L. 1-5).

Claim 8. Said method, wherein the simulated facial image is one of two-dimensional image and a three-dimensional image (Fig. 6).

Claim 9. Said method, wherein the simulated facial image is displayed on a simulated likeness of at least a portion of a human (C. 2, L. 63-66).

Claim 10. Said method, further comprising enabling selection of at least one article of clothing, wherein the selected article of clothing is displayed on the simulated likeness (C. 10, L. 9-17).

Claim 11. Said method, wherein at least one of facilitating display of a plurality of templates, enabling selection of at least one of the displayed templates, and facilitating display of a simulated facial image comprises providing access to software (C. 6, L. 61-65; C. 3, L. 21-26).

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Claim 13. Said method, comprising enabling application of coloration to the simulated facial image to simulate at least one of actual skin tone and actual hair color (C. 10, L. 47-49).

Claim 14. Said method, wherein the beauty product comprises a cosmetic product chosen from mascaras, eye shadows, eye liners, foundations, concealers, blushers, lip make-ups, lip sticks, lip glosses, and hair colorings (C. 10, L. 47-49).

Claim 15. Said method, wherein further comprising enabling storage of the simulated facial image for selective recall by an individual (C. 4, L. 29-50).

Claim 19. Said method, wherein the beauty product comprises make-up (C. 5, L.1-5).

Claim 20. Said method, further comprising displaying the plurality of templates, wherein enabling selection comprises selecting at least one of the displayed templates, and wherein facilitating display of the simulated facial image comprises displaying the simulated facial image (Figs. 12-18; C. 6, L. 66 - C. 7, L. 13).

Claim 21. Said method, wherein the plurality of templates comprise a group of templates each having substantially the same shaped facial portion (lips) along with a simulation of a differing beauty product (liner products and lipstick products) (Figs. 12 and 13; C. 6, L. 30-33).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Orpaz et al. in view of Lambertsen (US 2002/0024528).**

### **Dependent Claim**

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Claim 12. Orpaz teaches all the limitations of Claim 12, except specifically teaching selecting at least one of a size and a shape for at least one of a head, eyes, nose, lips, ears, and eye brows.

Lambertsen teaches a virtual makeover system and method, wherein users can apply beauty products to an image of a human, and wherein various portion of a facial image including a head, eyes, nose, lips, ears, and eye brows are provided with a default shape, said default shape can be changed (reshaped) by the user (Fig. 4; [0010]; [0011]).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Orpaz to include selecting at least one of a size and a shape for at least one of a head, eyes, nose, lips, ears, and eye brows, as disclosed in Lambertsen, because it would advantageously allow users to create a new "look" not only for themselves, but for other user as well, thereby potentially increase revenue (Lambertsen; [0011]).

## (10) Response to Argument

### (10. 01) Argument A. (Brief, pages 10-12).

Applicant argues that the rejection of claims 1 Under 35 U.S.C. § 101 should be reversed, because claims 1 provide a concrete, tangible and useful results.

In response to applicant's argument the examiner points out that an invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a *machine, manufacture, **process** or composition of matter*, which produces a concrete, tangible, and useful result (see the discussion above). In this case, method **claim 1** recites:

Based on the definitions of terms "facilitating" and "enabling" provided by the specification, the method claim 1 does not require the actual act of "displaying" to be performed, and the method step of "enabling selection of at least one of the displayed templates" neither require the actual selection step to be performed, nor does it guarantee the expected result of the selection step, and can be understood as merely having an idea about how to arrange the selection of the information.

Furthermore, the method steps recited in the claim, including said "displaying" and "selecting" steps, does not recite any electrical, chemical, or mechanical acts or results, typical in traditional process claims. The claim does not require any machine or apparatus to perform the recited steps; and, finally, the claim does not provide any physical transformation of an article to a different state or thing, nor does it require any transformation of data or signals. However, "...a process claim [in] compliance with Section 101 requires some kind of transformation or reduction of subject matter." See *In re Schrader*, 22 F.3d 295, 30 USPQ2d at 1459.

So as the method claim 1 does not require any machine or apparatus to perform the recited steps, and does not require implementing a mathematical formula or algorithm to transform data, the information recited in the claim does not represent a real world activity such as found in *Arrhythmia*, *Alappat*, or *State Street*. As such, claim 1 falls outside the scope of § 101 as failing to apply its abstract idea to produce a useful and concrete and tangible result.

(10. 02)      Argument B. (Brief, pages 12-15).

(10.021)      Applicant argues that the rejection of claims 1-11 and 13-21 Under 35 U.S.C. § 102(e) should be reversed. Specifically, Applicant argues that Orpaz does not disclose (claim 1):

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*"facilitating display of a plurality of templates, wherein at least some of the templates are representative of a portion of a face having a simulation of use of a beauty product".*

In response to this argument, the examiner points out that the recited step requires that only some of the templates *are representative of a portion of a face having a simulation of use of a beauty product*.

Orpaz discloses an image simulation graphic interface (ISI) 33, including a *central picture and category list* (plurality of templates) including eyes and lips & face, which, *when selected*, provide more detailed choices (subcategories), i.e., lipstick, lip-gloss, lip pencil, eye shadow, eyeliner, mascara, eye pencil, etc. (Fig. 3; C. 3, 34-43). Furthermore, Orpaz specifies that for each base image, one or more make-up application areas (templates) are defined for each make-up product type (C. 5, L. 66 - C. 6, L. 1). Orpaz further provide examples of said make-up application areas (templates) including lips areas for lipstick or lip liner products, cheeks area for blush products, eyes area for eye shadow products (Figs. 12-18; C. 6, L. 20-41).

(10.022) Applicant further argues that Orpaz does not disclose (claim 1):  
*"enabling selection of at least one of the displayed templates".*

In response to this argument, the examiner points out that the recited step does not specify which template is selected. Accordingly, so as only some of the templates *are representative of a portion of a face having a simulation of use of a beauty product* (see "*displaying*" step), the selected template can be any one of said, disclosed in Orpaz, *central picture and category list* (plurality of templates) including eyes and lips & face, which, when selected, provide more detailed choices (subcategories), i.e., lipstick, lip-gloss, lip pencil, eye shadow, eyeliner, mascara, eye pencil, etc. (Fig. 3; C. 3, 34-43). Furthermore, Orpaz explicitly teaches the step of selecting a desired category (template) by highlighting or clicking upon (C. 3, L. 36-37).

(10.023) Applicant further argues that Orpaz does not disclose (claim 1):

*“facilitating display, on the display device, of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion of the simulated facial image corresponds to a facial portion of the at least one selected template, and wherein simulation of the displayed facial portion corresponds to a simulation of the at least one selected template”.*

In response to this argument, the examiner points out that the recited step does not specify which template is selected, and to which template said *displayed facial portion of the simulated facial image corresponds*. Accordingly, so as only some of the templates are representative of a portion of a face having a simulation of use of a beauty product (see “displaying” step), the selected template can be any one of said, disclosed in Orpaz, central picture and category list (plurality of templates) including eyes and lips & face, which, when selected, provide more detailed choices (subcategories), i.e., lipstick, lip-gloss, lip pencil, eye shadow, eyeliner, mascara, eye pencil, etc. (Fig. 3; C. 3, 34-43). Accordingly, the at least one selected template which the displayed facial portion of the simulated facial image corresponds to can be any one from said category list (plurality of templates) in Orpaz.

Accordingly, Orpaz explicitly teaches this feature (C. 6, L. 66 - C. 7, L. 13):

“To *simulate* the appearance of the selected product on the base image of the user, the color information of the selected product is modified and blended to the color information of the base image, in steps 5000 and 6000, to create a composite image.

In the modification step 5000, the appearance information of the base image (or at least the appearance information of the associated make-up application area) is modified, *simulating* the physical process of color application ...”

(10.024) Applicant further argues that Orpaz does not disclose the limitations of method claim 18.

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So as applicant's arguments in respect to claim 18 essentially repeat the arguments presented above in respect to claim 1, the responses presented by the examiner above in respect to claim 1 are equally applicable to the remaining applicant's arguments.

(10. 03)      Argument C. (Brief, pages 15-17).

(10.031)      Applicant argues that the rejection of claim 12 Under 35 U.S.C. § 103(a) should be reversed. Specifically, Applicant argues that Lambertsen does not disclose the limitations of *claim 1*:

*"facilitating display of a plurality of templates, wherein at least some of the templates are representative of a portion of a face having a simulation of use of a beauty product;*

*enabling selection of at least one of the displayed templates;*

*facilitating display, on the display device, of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion of the simulated facial image corresponds to a facial portion of the at least one selected template, and wherein simulation of the displayed facial portion corresponds to a simulation of the at least one selected template".*

In response to this argument it is noted that Orpaz discloses these features (See the discussion above).

(10.032)      Applicant argues that Lambertsen fails to disclose (claim 12):

*"selecting at least one of a size and a shape for at least one of a head, eyes, nose, lips, ears and eyebrows".*

In response to this argument it is noted that Lambertsen discloses a virtual makeover method and system, wherein users can apply beauty products to an image of

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a human, and wherein various portion of a facial image including a head, eyes, nose, lips, ears, and eye brows are provided with a default shape, said default shape can be changed (reshaped) by the user (Fig. 4; [0010]; [0011]).

(10.033) Applicant argues that Lambertsen does not disclose that (claim 12):  
“various portions of the facial image can be changed, but rather discloses that  
“outlines” superimposed on the image can be changed”.

In response to this argument the examiner points out that Lambertsen explicitly teaches said “reshaping” feature:

[0011] In one aspect of the present invention, users can send the photograph with the *saved outlined features* to other users. The selected features can include, for example, the face shape, which includes the forehead, left side, and right side of the face, the eyes, lips, eye creases, eyebrows, eye highlights, cheeks, and irises. Other features can include the head, eyeliners, eyelids, and eyelashes. Tools are also provided which allow the user to reshape, move, zoom in/out, add/delete points, rotate, or erase the default outlines. The tools are implemented in a manner similar to such tools provided with computer graphics programs, and are implement by moving a pointer, clicking on property or task selection buttons, and the like. A virtual brush with a color palette, and an eyedropper for painting and removing red-eye can also be provided.

What Applicant argues (superimposing of “outlines”) is simply a part of the process of changing various portions of the facial image:

[0010] Once a photograph is uploaded or selected, the user then identifies the basic parameters of the head and face in the photograph using adjustable guides. Then, the user selects various features in the photograph and outlines these features. During the outlining step, the user defines the size and shape of a specific feature for which future treatment or manipulation is desired. Preferably, a default shape is provided for each feature which consists of several points connected by lines to form a shape. The user outlines the feature by selecting and moving the one or more points to alter the orientation of connected lines, thus creating a new shape. Once each feature is outlined, the user can save the newly formed shapes in connection with the particular photograph.



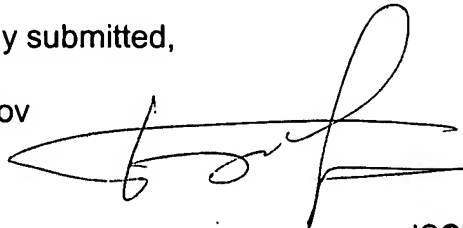
**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Igor Borissov

A handwritten signature in black ink, appearing to be 'Igor N. Borissov', written in a cursive style.

IGOR N. BORISSOV  
PRIMARY EXAMINER

Conferees:

Vincent Millin

A handwritten signature in black ink, appearing to be 'Vincent Millin', written in a cursive style.

John W. Hayes

A handwritten signature in black ink, appearing to be 'John W. Hayes', written in a cursive style.